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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/860,844	09/29/1997	SUSAN WEININGER	GP-100C1	9470

7590 02/25/2002

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EXAMINER

MARSCHER, ARDIN H

ART UNIT PAPER NUMBER

1631

DATE MAILED: 02/25/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.  
**08/860,844**

Applicant(s)  
**Weininger et al.**

Examiner  
**Ardin Marschel**

Art Unit  
**1631**



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on Nov 7, 2001
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 28, 29, and 49 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 28 and 49 is/are rejected.
- 7) ☒ Claim(s) 29 is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 9/11/01 is/are objected to by the Examiner. *See informality objection.*
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: ☐ approved ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some\* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892) 18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 19) ☐ Notice of Informal Patent Application (PTO-152)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_ 20) ☐ Other: \_\_\_\_\_

The request, filed 11/7/01, for a Continued Prosecution Application (CPA) under 37 CFR 1.53(d) based on parent Application No. 08/860,844 is acceptable and a CPA has been established. An action on the CPA follows. The amendment, filed 9/11/01, has now been entered.

Applicants' arguments, filed 9/11/01 and 11/7/01, have been fully considered but they are not deemed to be persuasive. Rejections and/or objections not reiterated from previous office actions are hereby withdrawn. The following rejections and/or objections are reiterated. They constitute the complete set presently being applied to the instant application.

The following is a quotation of 35 U.S.C. § 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

This application currently names joint inventors. In

considering patentability of the claims under 35 U.S.C. § 103, the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 C.F.R. § 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of potential 35 U.S.C. § 102(f) or (g) prior art under 35 U.S.C. § 103(a).

Claim 28 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Frankel et al. (P/N 5,674,980).

This rejection is reiterated and maintained from the previous office action, mailed 5/7/01, and as discussed in the Advisory Action, mailed 9/25/01. This rejection is firstly argued regarding the amending which is directed to specificity of binding or targeting. Now that the amendment has been entered, this rejection still has not been overcome by this argument. This is because the reference has a recited specificity of certain targets over non-targets and thus contains the necessary *prima facie* case regarding specificity. Applicants have not indicated why the specific binding to E2 sites is not a specificity as claimed or proposed to be claimed in that there is no claim limitation that has been set forth wherein selectivity as specific as being selective of particular E2 sites over others is required in instant claim 28. Applicants then set forth a previous examiner's reasons for allowance. In response this reasons for allowance indicates that stabilizing "perfect" hybrids versus potential hybrids with one or more mismatch is the

basis for the novelty and non-obviousness. None of this particular specificity is claimed herein and thus this is insufficient to distinguish the reference from the instant invention.

Claim 49 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Essigmann et al. (P/N 5,882,941).

This rejection is maintained and reiterated from the previous office action, mailed 5/7/01, and as discussed in the Advisory Action, mailed 9/25/01. This rejection is solely argued regarding the content of non-nucleic acid recognition units in the reference. This is non-persuasive because the open claim language term "comprising" is present in claim 49 regarding the content of TBA(s) thus being inclusive of other entities as in Essigmann et al. in the TBA therein described.

The disclosure is objected to because of the following informalities:

The specification contains a section entitled "Brief Description of the Drawings" starting on page 7. These Brief Descriptions are confusing regarding a lack of correspondence between the capitalization or not of designations of Figures and subparts thereof. For example, on page 9, line 19, and on page 37, line 26; a Figure 12b are cited but confusingly there is no Figure 12b in the Figures but rather a Figure 12B.

Appropriate correction is required.

Claim 29 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

No claim is allowed.

Papers related to this application may be submitted to Technical Center 1600 by facsimile transmission. Papers should be faxed to Technical Center 1600 via the PTO Fax Center located in Crystal Mall 1. The faxing of such papers must conform with the notices published in the Official Gazette, 1096 OG 30 (November 15, 1988), 1156 OG 61 (November 16, 1993), and 1157 OG 94 (December 28, 1993) (See 37 CFR § 1.6(d)). The CM1 Fax Center number is either (703)308-4242 or (703)305-3014.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ardin Marschel, Ph.D., whose telephone number is (703)308-3894. The examiner can normally be reached on Monday-Friday from 8 A.M. to 4 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Woodward, Ph.D., can be reached on (703)308-4028.

Any inquiry of a general nature or relating to the status of this application should be directed to Patent Analyst, Tina Plunkett, whose telephone number is (703)305-3524 or to the Technical Center receptionist whose telephone number is (703) 308-0196.

February 22, 2002

*Ardin H. Marschel*  
ARDIN H. MARSCHEL  
PRIMARY EXAMINER